

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of this application in view of the following remarks. At this time, claims 4, 7-17, 20, 21 and 23-44 are pending in this case, with claims 4, 7, 8, 14, 15, 20, 23, 24, 27 and 36 being independent claims, and claims 27-44 having been previously withdrawn from prosecution in response to a restriction requirement. It is believed that no fees are due for the consideration of this paper. However, if fees are due, the Commissioner is authorized to charge such fees to deposit account number 13-2855. A copy of this paper is enclosed.

Claim Rejection Under 35 U.S.C. §§ 102(b) and 103(a)

Claims 7-9, 13, 20, 23 and 24 were rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as obvious over, McKay (U.S. Patent No. 4,005,543), claims 4, 10, 11, 12 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over McKay in view of Kulesza et al. (U.S. Patent No. 4,820,300), and claims 14-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over McKay in view of Althaus (U.S. Patent No. 3,387,778), and claims 21, 25 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over McKay in view of Kulesza *et al.* and further in view of Althaus. Applicants respectfully traverse these rejections and request reconsideration in view of the following remarks.

Referring first to the claims rejected in view of McKay alone, claims 7, 20 and 23 each recite an action figure game piece having a mechanically functional combat component configured to physically engage other action figure game pieces in simulated battles. As opined in the Office action, applicants respectfully submit that the plane 12 of McKay is not a mechanically functional combat component as recited in claims 7, 20 and 23 because the plane 12 is not configured to engage other cars in simulated battles. The planes 12 are propelled from the cars 10, but McKay does not disclose or suggest that the planes 12 engage, or are configured to engage, other cars or planes 12 to simulate battles. The Office action cites to the passage at column 4, lines 15-29 of McKay for motivation to modify the plane 12 to be a combat component. Applicants respectfully submit that any modifications suggested in that portion of the specification relate to the plane's flight capabilities and, as noted in the

Office action, to the plane's aesthetic appearance, and do not relate to the engagement of other cars or planes in simulated battles. Because McKay does not disclose a combat component configured to physically engage other game pieces, and does not suggest configuring the plane 12 to engage other planes or cars, it follows that claims 7, 20 and 23 are neither anticipated nor rendered obvious by McKay.

Claims 8 and 24 recite a second portion of a game figure character moveably connected to a first portion and moveable to engage an adjacent game piece when the second game piece moves from a second position to a first position under the biasing force of a spring. The latch 30 identified in the Office action as corresponding to the second portion does not meet all the limitation recited in the claim. The latch 30 is disposed within a groove 18 and a slot 32 of the car, and does not extend beyond the perimeter of the car at any point during the movement of the latch 30 along the slot 32 as can be seen from the various views of the car provided in Figs. 2-7 of McKay. Moreover, McKay does not suggest modifying the latch 30 to have any portion thereof extend beyond the perimeter of the car in any direction, let alone in a manner such that the latch 30 could engage an adjacent car. No other component of McKay's car is disclosed or suggested as being biased by a spring or engaging an adjacent car. For these reasons, neither claims 8 and 24, nor any claims depending therefrom, are anticipated or rendered obvious by McKay.

Turning now to the rejections in view of McKay and Kulesza *et al.*, claim 4 is not rendered obvious by the proposed combination for multiple reasons. First, claim 4 recites a mechanically functional combat component in a similar manner as recited in claim 8. As discussed above, McKay does not teach or suggest a combat component as recited. Kulesza *et al.* does not teach or suggest any combat component, let alone a combat component as recited in the claims. Therefore, the combination of McKay and Kulesza *et al.* does not render claim 4 obvious for at least this reason.

Further, there is no suggestion or motivation for combining the references in the manner proposed in the Office action to yield the action figure game piece of claim 4 having visual and audible distance indications and, consequently, the Office action does not establish a *prima facie* case of obviousness. McKay offers no suggestion or motivation for adding a mechanism providing an audible indication of distance in addition to the visual indication

provided as actuator 70 moves passed the indicia on the spoiler 74. Kulesza *et al.* teaches a toy vehicle having a speed indicating device providing a visual indication of a distance traveled and a sound producing assembly providing an audible indication, but Kulesza *et al.* does not teach or suggest adding a combat component as recited in claim 4 or any other component for engaging another vehicle or game piece as recited in claim 4. Therefore, neither reference provides the necessary suggestion or motivation for combining the references with each other in the manner proposed in the Office action.

Moreover, the Office action does not provide the necessary actual evidence of a suggestion or motivation for combining the references in the proposed manner. The Office action provides a conclusory assertion regarding combining the references based on children being attracted to devices that produce sound, and audible indications making the device acceptable to visually challenged individuals. Applicants respectfully submit that these conclusory statements do not satisfy the requirement of actual evidence from combining two particular references in the proposed manner. The only suggestion of such a combination is provided in applicants' own disclosure, the use of which constitutes impermissible hindsight analysis. *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983) (It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.). It is clear that the prior art must make a suggestion of or provide an incentive for the claimed combination of elements for the examiner to be able to establish a *prima facie* case of obviousness. See, *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Because McKay and Kulesza *et al.* fail to disclose or suggest combining their teachings in the manner proposed in the Office action, and the Office action has not cited any other reference providing a suggestion or motivation for such a combination, it follows that the references cannot render claim 4 obvious.

Regarding claims 10-12, applicants respectfully submit that Kulesza *et al.* do not provide the teaching or suggestion of a second portion of the game figure missing from claim 8 as discussed above. Therefore, the combination of McKay and Kulesza *et al.* does not render claims 10-12 obvious for at least this reason.

Regarding the rejections in view of McKay and Althaus, claims 14 and 15 recite a combat component similar to that recited in claim 8 and, consequently, are not rendered obvious by McKay and Althaus for at least this reason because Althaus does not disclose or suggest any combat components. Further, Althaus does not recite a distance measuring device as recited in claim 14. Althaus does not disclose a wheel secured to an axle and engaging the surface. The components of Althaus identified in the Office action as corresponding to the wheel are in fact circular weights 40 attached to the shaft 42 that are suspended by the side walls 14 to prevent rotation of the shaft 42 as the hoop 10 rolls along the ground. The weights 40 do not engage the surface. Additionally, Althaus does not teach or suggest a circular rack having a surface with any indicia, let alone circumferentially spaced indicia as recited in claim 14. The indicia 30 identified in the Office action as being disposed on the gear 48 are in fact disposed on a wheel of a counter 24, and not on the gear 48. Moreover, Althaus provides no disclosure or suggestion of a surface of the gear 48 being visible through an aperture of a face plate. Therefore, Althaus does not teach a distance measuring device as recited in claim 14 for at least these reasons, and the combination of McKay and Althaus do not render claim 14 obvious for these additional reasons.

Claim 15 recites, *inter alia*, a display device alternately displaying and shielding indicium indicative of a special characteristic of a game piece. McKay and Althaus each teach only distance measuring devices, and neither teaches or suggests an additional display device for displaying indicia indicative of characteristics other than distance. Conversely, claim 15 recites both a distance measuring device and a display device for a special characteristic of the game piece. Even if McKay and Althaus were combined, the distance device of Althaus would be substituted for the distance device of McKay, and the combination would include only a single device for displaying distance, and not a distance device and a separate display device as recited in claim 15. Therefore, claim 15 and the claims depending therefrom not rendered obvious by McKay and Althaus for this additional reason.

Finally, regarding the rejection of claims 21, 25 and 26 in view of McKay, Kulesza *et al.* and Althaus, claims 21 and 25 recite limitations similar to limitations recited in claims 14 and 15, respectively. As a result, claims 21, 25 and 26 are patentable over the proposed

combination for at least the applicable reasons as discussed above for the corresponding limitations.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

Dated: October 7, 2005

Respectfully submitted,

By: Scott E. Baxendale
Scott E. Baxendale
Registration No.: 41,605
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicants